

## **REMARKS**

### **Status of Claims**

The Office Action mailed July 12, 2006 has been received and reviewed. Each of claims 1, 5-6, 9, 15 and 16-20 stands rejected. Each of claims 8, 9, and 14 has been amended herein. Reconsideration of the present application in view of the above amendments and following remarks is respectfully requested.

### **Objection to Informalities**

Claim 9 was objected to because of a minor scrivener's error. Applicants thank the Office for pointing out this error. Claim 9 is amended to replace "the" with "that." Accordingly, the objection to claim 9 should be withdrawn.

### **Rejection under 35 U.S.C. §101**

The Office rejects claims 8 and 14 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Office contends that a modulated signal is non-statutory subject matter. Applicants have amended claims 9 and 14 to change "computer-readable" medium to "machine-readable" medium. Accordingly, the rejection of claims 8 and 14 should be withdrawn.

### **Rejection Under 35 U.S.C. §103(a)**

#### **A.) Applicable Authority**

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP §2143 through §2143.03. In order "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)". See MPEP §2143. Further, in establishing a *prima facie* case of obviousness, the initial burden is placed on the Examiner. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985)." *Id.* See also MPEP §706.02(j) and §2142.

B.) Obviousness Rejections Based on U.S. Patent No. 5,586,237 issued to Baecker et al. (hereinafter Baecker), U.S. Patent No. 6,545,687 issued to Scott et al. (hereinafter Scott), U.S. Patent No. 6,947,959 issued to Gill et al. (hereinafter Gill), and U.S. Patent No. 5,680,558 issued to Hatanaka et al. (hereinafter Hatanaka).

Claims 1, 5-8, 16, 17, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baecker, Scott, Gill, and Hatanaka. As Baecker, Scott, Gill, and Hatanaka, whether taken alone or in combination, fail to teach or suggest all of the limitations of claims 1, 5-8, 16, 17, and 20, Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants respectfully submit that independent claims 1 and 16 are allowable over the cited prior art because all limitations of claims 1 and 16 are not taught or suggested. With respect to independent claim1, Baecker, Scott, Gill and Hatanaka fail to teach or suggest, among

other things, “selecting, from the generated list, a desired number of items to display on the outer appearance based upon a sort criteria, wherein the sort criteria selects the items based upon those items which were most recently modified.” Similarly, with respect to independent claim 16, Baecker, Scott, Gill and Hatanaka fails to teach or suggest, among other things, “sorting content items that can be graphically represented, rendering graphical previews, on the background appearance, of the sorted content items that can be graphically represented.”

The Office action concedes that Baecker, Scott, and Hatanaka fail to teach or suggest the claimed sorting of graphical previews to display on the outer or background appearance. However, the Office contends that Gill in combination with Baecker, Scott and Hatanaka discloses the claimed sorting of graphical previews. Applicants respectfully disagree. Gill discloses, at FIG. 10, a query interface that is utilized to formulate search criteria for digital assets. Gill, at column, 17, lines 60-65, column 18, lines 5-10, FIG. 11, and FIG. 20, further discloses a “query palette,” which is a results interface that displays the results of the query, which include thumbnail images. Furthermore, Gill, at column 17, lines 5-6, discloses that an accessories feature enables the user to group or sort the query results based on information included in headers associated with the digital assets. Gill, at column 16, lines 10-15 discloses that the header includes date of last modification.

Unlike Baecker, Scott, Gill and Hatanaka, the claimed embodiment expressly requires displaying sorted items on the outer appearance of a container or background appearance. Nothing in Gill teaches or suggests that the “query palette” is an outer representation of a container or a background appearance. The claimed embodiment requires a sort to be applied to the collection of items within the container having the outer appearance or to the collection of content items associated with the background appearance. Nothing in Baecker, Scott, Gill and

Hatanaka fairly teaches or suggests applying the claimed sort to a container of items that are graphical previewed on an outer appearance or background appearance of a container. Rather, Gill in combination with Baecker, Scott, Gill, and Hatanaka suggests sorting search results, which is distinct from sorting graphical previews of items within the container. Accordingly, for at least the foregoing reasons, the obviousness rejection of claims 1 and 16 should be withdrawn.

Dependent claims 5-8, 17, and 20 depend on claims 1 and 16 and further define novel features of the claimed invention. Accordingly, for at least the reasons set forth above, claims 5-8, 17, and 20 are allowable by virtue of their dependence on claims 1 and 16.

Claims 9-12, 14, 15, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baecker, Scott, and Gill. As Baecker, Scott, and Gill, whether taken alone or in combination, fail to teach or suggest all of the limitations of claims 9-12, 14, 15, 18, and 19, Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants respectfully submit that independent claims 9 and 15 are allowable over the cited prior art because all limitations of claims 9 and 15 are not taught or suggested. With respect to independent claim 9, Baecker, Scott, and Gill fail to teach or suggest, among other things, "sorting the content items that can be graphically represented based on a sort criteria and displaying on said background appearance graphical previews for the sorted content items that can be graphically represented." With respect to independent claim 15, Baecker, Scott, and Gill fail to teach or suggest, among other things, "sorting the collection of items based on a sort criteria, [and] displaying graphical previews of the sorted items on the background appearance of the container."

As discussed above, the Office concedes that Baecker and Scott fails to teach or suggest the claimed sorting of items within a container and displaying the sorted items on the

background appearance of the container. However, the Office contends that Gill in combination with Baecker and Scott teaches or suggests displaying sorted graphical previews on a background appearance of a container. Applicants respectfully disagree. Gill, describes a query palette that provides search results in response to a search query. The query palette is configured to display thumbnails. The query palette includes accessories that may be utilized to group or sort the results based on header information, such as modification time or file name. Baecker, at column 6, lines 45-55 discloses animated folders that display at least three frames, where the first two frames do not include content. Scott, at column 11, lines 45-55, and column 12, lines 6-20 discloses containment areas that are created to include images having a specified aspect ratio. Scott, at column 13, lines 40-46 and FIG. 14, further discloses a window where the containment areas are represented by folders. In Baecker, Scott, and Gill, background or outer appearances of containers, such as folders, are not utilized to display sorted graphical previews. At best, the combination of Baecker, Scott, and Gill provides the ability to search for items and display sorted thumbnails associated with the items in a query palette, as an animate collection or as hierarchical collections of containment areas.

Unlike Baecker, Scott, and Gill, singularly and in combination, embodiments of the invention sort content items that can be graphically represented and display graphical previews for the sorted content items. The sort criteria prevent the rendering of the entire collection of content items on the outer appearance of the container. The combination of Baecker, Scott, and Gill fails to teach or suggest the claimed sort criteria. Accordingly, for at least the foregoing reasons, the obviousness rejection of claims 9 and 15 should be withdrawn.

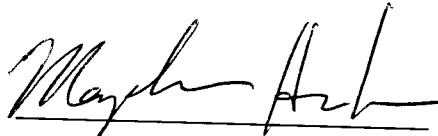
Dependent claims 10-12, 14, 18 and 19 depend on claims 9 and 15 and further define novel features of the claimed invention. Accordingly, for at least the reasons set for the above, claims 10-12, 14 and 18-19 are allowable by virtue of their dependence on claims 9 and 15.

### CONCLUSION

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated, since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a Petition for an Extension of Time sufficient to effect a timely response. Please charge any deficiency in fees or credit any overpayments to Deposit Account No. 19-2112 referencing Attorney Docket No. MFCP.88143.

Respectfully submitted,



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